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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,515	10/06/2005	Ira Pastan	4239-68223-02	1944

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EXAMINER	
GODDARD, LAURA B	

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/552,515	PASTAN ET AL.	
	Examiner	Art Unit	
	Laura B. Goddard, Ph.D.	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-46* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 26-30, and 39, drawn to the special technical feature of a polypeptide comprising SEQ ID NO:1, a method for producing an immune response against a cell expressing a polypeptide of claim 1 in a subject comprising administering the polypeptide of claim 1, and a pharmaceutical composition comprising the polypeptide of claim 1.

Group II, claim(s) 6-11 and 40, drawn to the special technical feature of a polynucleotide encoding the polypeptide of claim 1, a polynucleotide comprising SEQ ID NO:2, and a pharmaceutical composition comprising the polynucleotide of claim 6.

Group III, claim(s) 12-16 and 41, drawn to the special technical feature of an antibody that specifically binds the polypeptide of claim 1 and a pharmaceutical composition comprising the antibody of claim 12.

Group IV, claim(s) 17-20, drawn to the special technical feature of a method for detecting prostate cancer in a subject comprising contacting a sample obtained from the subject with the antibody of claim 12.

Group V, claim(s) 21-25, drawn to the special technical feature of a method for detecting a prostate cancer in a subject comprising detecting the expression of the polypeptide of claim 1 wherein an increase in the expression of the polypeptide indicates the presence of the prostate cancer.

Group VI, claim(s) 31, drawn to the special technical feature of a method for inhibiting the growth of a malignant cell expressing the polypeptide of claim 1 comprising culturing CTLs or CTL precursor cells with the polypeptide of claim 1 to produce activate CTLs or CTL precursors that recognize an NGEP expressing cell and contacting the malignant cell with the activated CTLs or CTL precursors.

Group VII, claim(s) 32-38, drawn to the special technical feature of a method for inhibiting the growth of a malignant cell comprising contacting the malignant cell with a cell-growth inhibiting molecule which comprises an antibody which specifically binds a polypeptide comprising SEQ ID NO:1 or as described in claim 1, wherein the antibody is linked to an effector molecule which inhibits the growth of cells.

Group VIII, claim(s) 42, drawn to the special technical feature of a method for reducing the number of prostate cancer cells in a subject comprising administering to the subject the polypeptide of claim 1 wherein the administration of the NGEP results in an immune response to NGEP and reduces the number of prostate cancer cells in the subject.

Group IX, claim(s) 43, drawn to the special technical feature of a method for reducing the number of prostate cancer cells in a subject comprising administering to the subject the polynucleotide of claim 6 wherein the administration of the polynucleotide results in an immune response thereby reducing the number of prostate cancer cells in the subject.

Group X, claim(s) 44, drawn to the special technical feature of a method for reducing the number of prostate cancer cells in a subject comprising administering to the subject the antibody of claim 16 thereby reducing the number of prostate cancer cells in the subject.

Group XI, claim(s) 45, drawn to the special technical feature of a kit for detecting a polynucleotide encoding NGEP in a sample comprising an isolated nucleic acid sequence of at least 10 nucleotides in length that specifically binds to SEQ DI NO:2 under highly stringent hybridization conditions.

The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
Groups I-XI encompass different special technical features as identified in the groupings above. The inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because under unity of invention between different *categories* of inventions unity of invention will only be found to exist if specific combinations of inventions are present.

A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. When claims to different categories are present in the application, the claims will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) A product and a process specially adapted for the manufacture of said product; or (2) A product and a process of use of said product; or (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or (4) A process and an apparatus or means specifically designed for carrying out the said process; or (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. The allowed combinations do not include multiple products (antibodies, nucleic acids, polypeptides), and multiple methods of using said products, as claimed in the instant application. The products themselves do not share significant structural elements to the extent that each member could be substituted, one for the

other, with the expectation that the same intended results would be achieved. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application is considered as the main invention in the claims, see PCT article 17(3) (a) and 1.476 (c), 37 C.F.R. 1.475(b) and (d). Group I is the main invention. After that, all other products and methods are broken out as separate groups (see 37 CFR 1.475(d).).

In the instant case, the first invention of the first category mentioned consists of the polypeptide of claim 1 and the first recited invention of use of said polypeptide is a method of producing an immune response against a cell expressing the polypeptide of claim 1 in a subject comprising administering to the subject the polypeptide of claim 1. Therefore, the polypeptide of claim 1 and the method comprising administering the polypeptide of claim 1 are considered the "main invention" and the remaining products and methods have been properly restricted into separate groups.

Note:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.

Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

SPECIES ELECTION
Species election for Group V

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species of **detecting expression of the polypeptide of claim 1** are as follows: **contacting the sample with an antibody that specifically binds the polypeptide (claim 23) or detecting the presence of mRNA encoding the polypeptide (claims 24 and 25).**

The following claim(s) are generic: claim 21. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each method of detection comprises different method steps utilizing structurally and functionally distinct reagents to detect structurally distinct molecules.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the

record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura B. Goddard, Ph.D. whose telephone number is (571) 272-8788. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura B Goddard, Ph.D.
Examiner
Art Unit 1642

JEFFREY SIEW
SUPERVISORY PATENT EXAMINER